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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,209	06/04/2001	Neal A. Brown	10431-005001	6091

7590 07/11/2003

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EXAMINER

SINGH, SUNIL

ART UNIT PAPER NUMBER


3673

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. <b>09/875,209</b>	Applicant(s) <b>Brown et al.</b>
Examiner <b>Sunil Singh</b>	Art Unit <b>3673</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-25, 28-32, and 34-49 is/are rejected.
- 7) ☒ Claim(s) 9, 26, 27, and 33 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Oct 5, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3673

## **DETAILED ACTION**

### ***Inventorship***

1. In view of the papers filed 4/28/03, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of Victor G. Grinius and Cam M. Shaar as inventors.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

### ***Drawings***

2. Figures 1A and 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claim 49 is objected to because of the following informalities: claim 49 appears as if it should depend from claim 46. Appropriate correction is required.

Art Unit: 3673

### *Specification*

4. The abstract of the disclosure is objected to because "is disclosed" should be omitted.

Correction is required. See MPEP § 608.01(b).

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Double Patenting*

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Art Unit: 3673

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4, 10, 13-20, 22-24, 34, 36, 39 and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al.

8. Claims 5-8, 11, 35, 37, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al. and Smith.

9. Claims 5-6, 8, 11-12, 35, 37-38, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al. and Brahtz.

Art Unit: 3673

10. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al. and Purcell, Jr. or Payne.

11. Claims 25, 28, 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al. and Watson.

12. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al. and Watson and Smith or Brahtz.

13. Claims 1-4, 10, 13-20, 22-24, 34, 36, 39 and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Shu et al.

14. Claims 5-8, 11, 35, 37, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Shu et al. and Smith.

15. Claims 5-6, 8, 11-12, 35, 37-38, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Shu et al. and Brahtz.

Art Unit: 3673

16. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No.6,349,664 in view of Shu et al. and Purcell, Jr. or Payne.

17. Claims 25, 28, 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Shu et al. and Watson.

18. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No.6,349,664 in view of Shu et al. and Watson and Smith or Brahtz.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

20. Claims 1-4, 10, 13-20, 22-24, 34, 36, 39, 42-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Shu et al. (US 6551029).

Art Unit: 3673

Shu et al. discloses a marine riser comprising a riser pipe (105), an annular sheath (see Figs. 2b- 4) surrounding the riser pipe and at least one pair of nozzles (108). System (101) for pumping water through the conduit. Independently and collectively selectable to discharge water (see col. 6 lines 1-3). Duct/pipes (107, see Fig.3). Tail jet (see Fig. 7, col. 6 lines 13-19). With regards to claim 24, see attached marked up Figure 4.

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 5-8, 11, 35, 37, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. in view of Smith (US 3894504).

Shu et al. discloses the invention substantially as claimed. However, Shu et al. is silent about having a rotatable sheath which includes a ring gear, pinion gear and gear motor. Smith teaches a rotatable sheath (24) which includes a ring gear (40), pinion gear (50) and gear motor (42). It would have been considered obvious to one of ordinary skill in the art to modify Shu et al. to include the rotating means as taught by Smith in order to reduce vortex induced vibration.

23. Claims 5-6, 8, 11-12, 35, 37-38, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. in view of Brahtz (US 3762352).

Art Unit: 3673

Shu et al. discloses the invention substantially as claimed. However, Shu et al. is silent about having a rotatable sheath which includes a ring gear, gear motor and controller. Brahtz teaches a rotatable sheath (12) which includes a ring gear (14), gear motor (20) and controller (18). It would have been considered obvious to one of ordinary skill in the art to modify Shu et al. to include the rotating means as taught by Brahtz in order to reduce vortex induced vibration.

24. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. in view of Purcell, Jr. or Payne (US 3614032, 3763810).

Shu et al. discloses the invention substantially as claimed. However, Shu et al. is silent about having a retractable tail. Purcell, Jr. and Payne both teach a retractable tail (42,199). It would have been considered obvious to one of ordinary skill in the art to modify Shu et al. to make his tail retractable as taught by either Purcell, Jr. or Payne in order to avoid damage to the tail when not in use.

25. Claims 25, 28, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. in view of Watson (US 4300855).

Shu et al. discloses the invention substantially as claimed. However, Shu et al. is silent about having a telescoping sheath. Watson teaches a telescoping sheath (see Figs. 5, 10). It would have been considered obvious to one of ordinary skill in the art to modify Shu et al. by making his sheath telescoping as taught by Watson in order to be able to use the marine riser in both deep and shallow waters.

Art Unit: 3673

With regards to claim 30, the structure is rotatable since the word rotatable means capable of rotating.

With regards to claim 31, the diameter of the cylindrical sections decreases (see Figs. 5 and 10 of Watson).

26. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. in view of Watson as applied to claim 25 above, and further in view of Smith '504 or Brahtz '352.

Shu et al. (once modified) discloses the invention substantially as claimed. However, the (once modified) Shu et al. is silent about having a rotatable sheath/cylindrical section. Smith and Brahtz both teach rotatable sheath/cylindrical sections (24, 12 respectively). It would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) Shu et al. to include the rotating means as taught by either Smith or Brahtz in order to reduce vortex induced vibration.

#### ***Allowable Subject Matter***

27. Claims 9, 26-27 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Art Unit: 3673

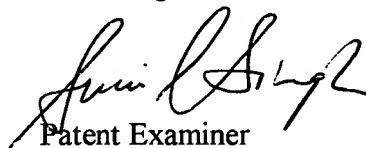
28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miller et al. '617 and Stanford '882 both teach means for reducing VIV.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Sunil Singh



Patent Examiner

Art Unit 3673

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